

## **REMARKS**

### **I. Background**

The present Amendment is in response to the Office Action mailed January 10, 2007. Claims 1-21 were pending in the application for consideration at the time of the mailing of the Office Action. Claims 1, 2, 7, 8, 11, 13, 14, 16, and 19 are currently amended. Thus, claims 1-21 are currently pending for consideration.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **II. Proposed Amendments**

#### **A. Specification**

Please amend the specification in the manner indicated above, where an underline represents new text, and strikeouts are used to indicate deleted text. The amendment to the paragraph starting at page 7, line 30 has been made merely to correct a typographical error. Thus, Applicants respectfully submit that the amendment to the specification does not introduce new matter and entry thereof is respectfully requested.

#### **B. Claims**

Please amend the claims in the manner indicated above, where an underline represents new text, and strikeouts are used to indicate deleted text. The amendments to claims 1, 2, 7, 8, 11, 13, 14, 16, and 19 are fully supported by the patent application as originally filed. More particularly, the amendment to independent claims 1, 7 and 8 are fully supported by claim 2 as originally filed. Thus, Applicants respectfully submit that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

### **III. Rejection on the Merits**

#### **A. Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Office Action rejects claims 13, 14, and 16-18 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicants have amended claims 13, 14, and 16 to particularly point out and distinctly claim the subject matter regarded as the invention.

With regard to claims 13 and 14, the Office Action asserts that "said forming" lacks antecedent basis. In response, Applicants have amended the claims to remove "wherein said forming comprises" and to include "further comprising."

With regard to claims 16-18, the Office Action asserts that "the assay plate" lacks antecedent basis. In response Applicants have amended claim 16, from which claims 17 and 18 depend, to recite "an assay plate" in place of "the assay plate."

Applicants respectfully submit that the amendments to claims 13, 14, and 16 overcome the rejection under 35 U.S.C. § 112, second paragraph, and withdrawal of the rejection to claims 13, 14, and 16-18 is respectfully requested.

#### **B. Rejections Under 35 U.S.C. § 102(b)**

The Office Action rejects claims 1-8 under 35 U.S.C. § 102(b) as being anticipated by *Monks et al.* (U.S. Patent No. 6,022,700). Applicants have amended independent claims 1, 7 and 8, thereby rendering the rejection moot.

The Office Action states that *Monks* discloses that the planar substrate described therein can be comprised of polymers and metals, and then alleges that such materials are flexible materials. Applicants respectfully object to such an assertion because *Monks* does not teach that such materials are flexible, and polymers and metals, as used in assay plates, are well known in the art to be prepared as rigid and inflexible. Additionally, the preferred embodiments of planar substrates described in *Monks* are glass, which is rigid and inflexible. Other materials disclosed in *Monks* are also rigid (*i.e.*, "crystal" and "silicon-based materials") (col. 11, lines 66-67), which further support the general sense that *Monks* only discloses materials that are rigid and inflexible. Moreover, the Office Action does not provide any citation in *Monks* that teaches or suggests that it is desirable or beneficial for the planar substrate to be flexible. Because glass, crystal, silicon-based materials and metals (*e.g.* stainless steel and nickel) are generally understood as being rigid, and because many polymers and plastics are also rigid, *Monks* cannot reasonably be understood as teaching a selection of materials that inherently provides a flexible substrate.

Applicants respectfully submit that *Monks* does not teach or suggest each and every element of the presently claimed invention of independent claims 1, 7 and 8. More particularly, *Monks* is completely void of any teaching or suggestion regarding an assay plate comprising "a *flexible substrate having a flexible substrate surface*," as recited in claim 1. Claim 7 is similar to claim 1 but claims "multiple raised pads". Further, *Monks* is completely devoid of any teaching or suggestion regarding a method of using an assay plate having a "*flexible substrate* with a raised pad extending from a *flexible substrate surface* thereof," as recited in claim 8. The materials that are disclosed in *Monks* are not inherently flexible, as required by the claims, but objectively understood as being rigid as discussed above. Thus, *Monks* does not disclose each and every element of independent claims 1, 7 and 8, either literally or inherently.

Claims 2-6 depend from independent claim 1, and thereby incorporate the limitations thereof. As such, Applicants submit that claims 2-6 are allowable over *Monks* for at least the same reasons as discussed above with regard to claim 1. Thus, the Applicants respectfully request reconsideration and withdrawal of the rejections to claims 1-8 under 35 U.S.C. § 102(b) relative to *Monks*.

The Office Action rejects claims 1-4, 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by *Webb et al.* (PG-PUB 2003/0124029). Applicant has amended independent claims 1, 7 and 8, thereby rendering the rejection moot.

Applicant respectfully submits that *Webb* does not teach or suggest each and every element of the presently claimed invention of independent claims 1, 7 and 8. More particularly, *Webb* is completely void of any teaching or suggestion regarding an assay plate comprised of "a *flexible substrate having a flexible substrate surface*," as recited in claim 1. Claim 7 is similar to claim 1 but claims "multiple raised pads". Further, *Webb* is completely void of any teaching or suggestion regarding a method of using an assay plate having a "*flexible substrate* with a raised pad extending from a *flexible substrate surface* thereof," as recited in claim 8. Also, nothing in *Webb* teaches or suggests that an assay plate having a "*flexible substrate*" that includes a "*flexible substrate surface*" would be desirable or beneficial. Thus, *Webb* does not teach or suggest each and every element of independent claims 1, 7 and 8.

Claims 2-4 depend from independent claim 1 and thereby incorporate the limitations thereof. As such, Applicants submit that claims 2-4 are allowable over *Webb* for at least the same reasons as discussed above with regard to claim 1. Thus, the Applicants respectfully

request reconsideration and withdrawal of the rejections to claims 1-4, 7, and 8 under 35 U.S.C. § 102(b) relative to *Webb*.

**C. Rejections Under 35 U.S.C. § 103(a)**

The Office Action rejects claims 12-15 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over *Monks*. Applicants respectfully traverse the rejection of claims 12-15 and 19-21 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

According to the applicable law, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. "Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczaik*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims." MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vacck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added).

In addition to the aforementioned allegations in the Office Action regarding *Monks*, the Office Action also alleges that "it would have been obvious to one of ordinary skill in the art to manufacture the device with a substrate that is flexible for the known and expected result of providing an alternative material of construction as is suggested in the art." Applicant

respectfully objects to this assertion because *Monks* does not suggest that the planar substrate is comprised of a flexible material, or that that a flexible planar substrate would be desirable or beneficial. Additionally, Applicant submits that the aforementioned remarks regarding *Monks* discussed under the 35 U.S.C. § 102(b) rejection are equally applicable here, and are incorporated into this remark by specific reference.

Applicant respectfully submits that *Monks* is completely void of any teaching or suggestion that would have motivated one of skill in the art to modify the teachings thereof in order to arrive at the presently claimed invention. More particularly, *Monks* is completely void of any suggestion to modify the teachings thereof to arrive at an assay plate having a "flexible substrate with a raised pad extending from a *flexible* substrate surface thereof," as recited in claim 8, or an assay plate having "a flexible substrate having a flexible substrate surface" and "at least one raised pad extending from said flexible substrate surface," as recited in claim 19. This is because nothing in *Monks* suggests an assay plate having a "flexible substrate" and flexible substrate surface" or that a flexible substrate and substrate surface would be desirable or beneficial for an assay plate. Thus, *Monks* does not provide any teaching or suggestion for modifying the teachings thereof to arrive at the presently claimed invention recited in independent claims 8 or 19. Moreover, the alleged motivation for providing a flexible substrate and substrate surface is found in Applicants' own disclosure, not in the prior art or even in the nature of the problem being solved by the device disclosed in *Monks*. There is nothing in the prior art or in the nature of the problem being solved that would have motivated one of skill in the art to replace the "glass" or other rigid substrate materials disclosed in *Monks* with a material that would yield a "flexible substrate having a flexible substrate surface".

Since *Monks* does not teach or suggest all of the elements claimed in independent claims 8 and 19, and *Monks* does not provide any suggestion for modifying the teachings thereof in order to arrive at all the elements claims in independent claims 8 and 19, a *prima facie* case of obviousness has not been established and/or cannot be maintained in view of the arguments set forth herein. Additionally, claims 12-15 depend from independent claim 8, and claims 20-21 depend from claim 19, and thereby incorporate the limitations thereof. As such, Applicant submits that claims 12-15 and 20-21 are allowable over *Monks* for at least the same reasons as discussed above with regard to claims 8 and 19. Thus, the Applicants respectfully request withdrawal of the rejections to claims 12-15 and 19-21 under 35 U.S.C. § 103(a).

The Office Action rejects claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Monks* in view of *Lichtenwalter* (PG-PUB 2001/0046682). Applicants respectfully traverse the rejection of claims 9 and 10 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established and/or cannot be maintained.

Applicant respectfully submits that *Lichtenwalter* does not teach or suggest the desirability of providing a flexible substrate such that it does not cure the foregoing deficiencies of *Monks* with regard to claim 8, and does not provide any motivation or suggestion for modifying the teachings of *Monks* in order to arrive at the presently claimed invention of claim 8. Since *Lichtenwalter* does not cure the deficiencies of *Monks*, Applicants submit that the combination of *Monks* and *Lichtenwalter* does not teach or suggest each and every element of independent claim 8.

Moreover, claims 9 and 10 depend from claim 8, and thereby include the limitations thereof and are allowable for the same reasons claim 8 is allowable. Thus, the Applicants respectfully request withdrawal of the rejections to claims 9 and 10 under 35 U.S.C. § 103(a).

The Office Action rejects claims 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Monks* in view of *Clayton et al.* (U.S. Patent No. 5,182,216). Applicant respectfully traverses the rejection of claims 9 and 11 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

Applicant respectfully submits that *Clayton* does not teach or suggest the desirability of providing a flexible substrate such that it does not cure the foregoing deficiencies of *Monks* with regard to claim 8, and does not provide any motivation or suggestion for modifying the teachings of *Monks* in order to arrive at the presently claimed invention of claim 8. Since *Clayton* does not cure the deficiencies of *Monks*, Applicants submit that the combination of *Monks* and *Clayton* does not teach or suggest each and every element of independent claim 8.

Claims 9 and 11 depend from claim 8, and thereby include the limitations thereof and are allowable for the same reasons claim 8 is allowable. Thus, the Applicants respectfully request withdrawal of the rejections to claims 9 and 11 under 35 U.S.C. § 103(a).

#### **D. Non-Statutory Double Patenting**

Finally, the Office Action rejects various claims on the grounds of non-statutory obviousness-type double patent relative to various claims of U.S. Patent No. 6,908,760 and U.S. application Serial No. 10/556,996. Without acquiescing in the rejections, but in an effort to

advance prosecution, Applicants are submitting herewith a Terminal Disclaimer, thereby rendering these rejections moot.

**SUMMARY**

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

Applicant believes claims 1-21 are in allowable form as discussed above. Thus, Applicant respectfully requests reconsideration of the application and allowance of presently pending claims.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney by telephone at (801) 533-9800.

Dated this 30<sup>th</sup> day of March 2007.

Respectfully submitted,



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